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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,725	07/15/2004	Michael Gruhn	2002P02987WOUS	4372

7590 06/30/2006
Siemens Corporation
Intellectual Property Department
170 Wood Avenue South
Iselin, NJ 08830

EXAMINER

CHARIOUI, MOHAMED

ART UNIT PAPER NUMBER

2857

DATE MAILED: 06/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/501,725

Applicant(s)

GRUHN ET AL.

Examiner

Mohamed Charioui

Art Unit

2857

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2006.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-13, 15 and 16 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 6-13, 15 and 16 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 31 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. Applicant cancelled claims 1-5, 14 and 17.

DETAILED ACTION

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 6-13, 15 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Hartikainen et al. (U.S. 6,298,377).

Hartikainen et al. teach an acquisition unit (i.e. device agent with PC 6) remote from at least one of the stationary power stations for collecting measurement data detected by sensors in the power stations (i.e. field devices in plants) (see col. 3, line 5 to col. 4, line 20; col. 9, lines 27-35; col. 2, lines 40-67; and col. 1, lines 8-11); a local diagnostics unit connected to the acquisition unit (i.e. device agent) for classification of operating states of the power stations that are represented by the measurement data (see col. 4, lines 4-21) a memory unit connected to the acquisition unit and the local diagnostics unit and the measurement data is centrally stored in the memory unit (see col. 5, lines 52-59; col. 3, lines 44-50 and col. 3, line 65 to col. 4, line 3); and a server unit connected to the memory unit that generates machine-readable data based on an

HTML language (see col. 4, lines 6-14; col. 3, lines 45-60; and col. 6, line 62 to col. 7, line 6).

Regarding plurality of remote stationary power stations (claim 12), Hartikainen et al. further teach diagnosing a plurality of remote stationary power stations (i.e. plurality of intelligent field devices) (see col. 4, lines 35-44)

Response to Arguments

3. Applicant's arguments filed 3/13/06 have been fully considered but they are not persuasive.

Examiner notes that there is no "field agent" term found in page 3 of the office action; however, the term "field devices" is found.

Applicant argues that the acquisition unit and the diagnostics unit as disclosed by Hartikainen et al. are not separate.

Examiner sees that the claims do not clearly states that the diagnostic unit and the acquisition unit are separate.

Moreover; Nerwin v. Erlichman, 168 USPQ 177, 179 (PTO Bd. Of Int. 1069)
The mere fact that a given structure is integral does not preclude its consisting of various elements.

The device agent of Hartikainen et al. contains all the necessary data and instruction sets for reading, analyzing and/or processing the status and diagnostic data of field devices. Therefore, the device agent of Hartikainen et al. could be made up of two separate codes embedded in two separate devices in communication with each

other, one device would be the acquisition unit and the other device would be the diagnostic device. Therefore, the Examiner maintains the rejection.

Contact information

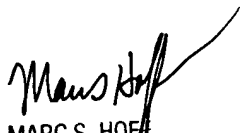
4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohamed Charioui whose telephone number is (571) 272-2213. The examiner can normally be reached Monday through Friday, from 9 am to 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marc S Hoff can be reached on (571) 272-2216. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mohamed Charioui

6/19/06


MARC S. HOFF
SUPERVISORY PATENT EXAMINER
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